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CASE CITED:

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Supreme Court of the United States

No.

GEORGE WASHINGTON PIERCE,

Petitioner,

—v.—

AMERICAN COMMUNICATIONS COMPANY, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

Petitioner's Argument

As we understand him, Petitioner is asking that this Court reverse an order granting Respondent's costs and refusing to grant costs to Petitioner because, according to Petitioner:

I. Respondent should pay the costs Petitioner incurred as a result of an allegedly false affidavit by Professor Edson; and

II. The summary judgment entered in this case was not a final judgment.

As to II, the petition should be dismissed on Petitioner's own admission (Petition page 12) that it is the same as the question which he presented to this Court in his "Sec-

ond Petition for Rehearing on his former Petition for Certiorari," and which was denied (348 U. S. 851).

THE ONLY QUESTION BEFORE THIS COURT IS WHETHER AN AWARD OR DENIAL OF COSTS IN THE DISTRICT COURT IS APPEALABLE. THE ANSWER IS NO. *Dubois* v. *Kirk*, 158 U. S. 58, 67 (1895).

There Has Been No Bad Faith on the Part of Respondent's Expert or Counsel

We believe that the foregoing is a complete answer to the petition. However, since Petitioner has again seen fit to level invectives at opposing expert and counsel we shall briefly answer lest our silence be construed as an admission of the completely unfounded charges.

Ever since the Court of Appeals reversed Judge Ford and held the Pierce patent invalid, Petitioner has unsuccessfully sought via numerous petitions and writs to reargue the merits of the case on the ground that Respondent's counsel had misled the Court.

We stand behind everything we said in our briefs and oral arguments and would repeat them if called upon to reargue the case.

The Edson Affidavit

There is no substance in Petitioner's charge that Professor Edson's original affidavit (R. 129a-165a) was false. Professor Edson said (R. 135a):

> "My retainer in this case afforded me (in October 1951) the opportunity of studying the history of this part of the radio art. Prior to that time I had assumed that Doctors Miller and Pierce were the origi-

nators of the circuits named for them. I now know that the work of Doctors Miller and Pierce, done in 1923, 1924 was anticipated by the work of A. M. Nicolson in 1918 and also by the work of W. G. Cady in 1921.

"Professor Bowles in his affidavit section 12 makes much of the fact that a particular oscillator circuit is commonly referred to as the 'Pierce-oscillator' and that another circuit is called the 'Miller' or 'Pierce-Miller.' However, in scientific circles the attachment of a name is often based upon early publication rather than on knowledge who the true inventor may be. For example, the 'Wheatstone bridge,' which is far more widely known than the Pierce type circuit was not invented by Wheatstone. On this point Professor Frederick A. Sanders (A Survey of Physics, Third Edition, 1944, Henry Holt & Co., New York) says, at page 380:

> "'A more accurate method of measuring resistances depends on a "bridge circuit" invented by Christie (1833) but usually known as the Wheatstone Bridge.'"

In his text book, the forthcoming publication of which was indicated in the affidavit, Professor Edson referred to an electrical circuit as a "Pierce" circuit.

The present case was the first judicial inquiry as to whether the work of Nicolson preceded and anticipated that of Pierce. Prior to this case, the only judicial inquiry had been as to priority rights between Miller and Pierce.

It was Professor Edson's opinion as expressed in his affidavit that Nicolson (as well as Cady) had the piezo-electric crystal controlled oscillator before Pierce and that the invention in the patent in suit had been claimed by

Pierce in his expired patent 1,789,496 (the latter opinion was shared by the Court of Appeals).

As stated in his second affidavit (R. A41-A43) Edson did not think that an engineering text book was the proper medium for discussing inventorship, but that familiar terminology should be employed.

In support of his opinion that Nicolson and Cady were ahead of Pierce, Professor Edson showed the following in his affidavit.

He quoted (R. 145a) three claims from Nicolson patent 2,212,845, and stated "These claims describe the same oscillator as in the Pierce claims which Professor Bowles construes in Section 13 [one of plaintiff's experts]."

Professor Edson then (R. 145a) referred to the following passage from page 287 of Professor Cady's book (which was introduced as *petitioner's* exhibit VI) to show that Pierce was not the first to construct a crystal-controlled oscillator:

> "Recently, the author was informed by Dr. Nicolson that he found in September, 1917, that the circuit represented in his Fig. 11 must have been oscillating at a frequency determined by a natural mode of the Rochelle-salt crystal. It is most unfortunate that the evidence was not published. In view of this statement, however, it appears that Nicolson was the first to construct a crystal-controlled oscillator—unless, indeed, Langevin's circuit was to some extent crystal controlled. Such findings were entirely unknown to the author in his investigations described above."

Long before this litigation started, Professor Pierce himself recognized the likelihood that Nicolson might have a piezo-electric crystal-controlled oscillator as defined in the

Nicolson claims, for we find in his license agreement with the American Telephone & Telegraph Company (R. 621a):

> "It is further agreed that as between the parties hereto the allowance in the applications of Nicolson Ser. No. 631,869* and Ser. No. 685,010 of any claims which the Patent Office shall determine are properly supported by the disclosures of said applications respectively, will not be contested by the other parties."

As point 10 of his affidavit, Professor Edson quoted (R. 147a) claim 1 of Cady patent No. 1,472,583 which, in his opinion described the same oscillator as Pierce patent 2,133,642 (the patent in suit).

The foregoing brief excerpts from Professor Edson's affidavit, show that his opinion concerning the Pierce patent was well-founded and the result of a careful and thorough study of the subject matter.

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* Ser. No. 631,869 is a misprint for Ser. No. 631,859 which resulted in Nicolson patent 2,212,845 (R 581a).

CONCLUSION

Under the guise of raising questions concerning Rules 54(b) and 56(g), Petitioner is attempting once more to get before the Court the merits of the case. The District Court did not consider Petitioner's contentions worthy of an opinion, and the Court of Appeals affirmed *Per Curiam*. This petition should likewise be summarily denied.

Respectfully submitted,

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